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THE DOW CHEMICAL COMPANY
9330 Zionsville Road
Indianapolis, IN 46268

In re Application of
FRANK *et al*
U.S. Application No.: 10/590,185
PCT No.: PCT/US05/05309
Int. Filing Date: 18 February 2005
Priority Date: 27 February 2004
Attorney Docket No.: 62644A
For: METHOD FOR THE EXTRACTION OF
INTERCELLULAR PROTEINS FROM A
FERMENTATION BROTH

**DECISION ON
PETITION
UNDER 37 CFR 1.497(d)**

This is a decision on applicants' "Response to Notification of Defective Response" filed 25 May 2007 requesting to add Jeffrey R. Allen as an inventor in the above-captioned national stage application. This is treated as a request under 37 C.F.R. 1.497(d).

BACKGROUND

On 06 March 2007, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee was required. Applicants were given two months to comply with extensions of time available pursuant to 37 CFR 1.136(a).

On 02 April 2007, applicants filed an executed declaration and surcharge fee.

On 30 April 2007, the DO/EO/US mailed a Notification of Defective Response (Form PCT/DO/EO/916) noting that the declaration filed 02 April 2007 listed an additional inventor than recorded on the international publication.

On 25 May 2004, applicants filed the subject response which was accompanied by, *inter alia*, a statement of inventive entity and authorization to charge any required fee to Deposit Account No. 04-1512.

DISCUSSION

Applicants request that Jeffrey R. Allen be added as inventor to the above-captioned national stage application of PCT/US05/05309. Applicants included a statement of inventive entity signed by the four named inventors in the international

application explaining that Mr. Allen "contributed to at least one claim of the application." Counsel also states that the error was made without deceptive intent. However, this does not meet the requirements for a grantable petition.

37 CFR 1.497(d) applies when the inventorship in a national stage application filed under 35 U.S.C. 371 differs from that set forth in the international application (see 37 CFR 1.48(f)(1)). 37 CFR 1.497(d) states, in part:

(d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, or a change to the inventive entity has been effected under PCT Rule 92 bis subsequent to the execution of any declaration which was filed under PCT Rule 4.17(iv), the oath or declaration must be accompanied by:

- (1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;
- (2) The processing fee set forth in § 1.17(i); and
- (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

Here, applicants have not provided the requisite statement from Mr. Allen. As such, item (1) is not satisfied.

The \$130.00 fee has been charged to Deposit Account No. 04-1512 as authorized. Item (2) is complete.

Applicants have also not provided the written consent of the assignee or addressed whether an assignment has been executed in the above-captioned national stage application. Applicants must address this item in their renewed petition. For this reason, item (3) is also not satisfied.

Therefore, all the requirements of 37 CFR 1.497(d) are not yet satisfied.

CONCLUSION

For the reason discussed above, applicants' request under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

Accordingly, the declaration filed 02 April 2007 is not yet in compliance with 37 CFR 1.497(a) and (b).

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Applicants must address items (1) and (3) of 37 CFR 1.497(d) above with any response. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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